

ESTTA Tracking number: **ESTTA619227**

Filing date: **08/04/2014**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	91216999
Party	Defendant Unilever Plc
Correspondence Address	JONATHAN D. REICHMAN KENYON & KENYON LLP 1 BROADWAY NEW YORK, NY 10004-1007 UNITED STATES tmdocketny@kenyon.com
Submission	Other Motions/Papers
Filer's Name	William M. Merone
Filer's e-mail	tmdocketny@kenyon.com, wmerone@kenyon.com
Signature	/William M. Merone/
Date	08/04/2014
Attachments	Motion to Suspend Opposition Proceeding.pdf(20497 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

TECHNOPHARMA LIMITED,

Opposer,

v.

UNILEVER PLC,

Applicant.

Opposition No.: 91216999

Serial Nos.: 85818821 and 85818836

**MOTION TO SUSPEND PROCEEDINGS DUE TO
PENDENCY OF RELATED BOARD ACTION**

Pursuant to TBMP Section 510.02(a) and Trademark Rule 2.117(a), Applicant, Unilever Plc, respectfully requests that the above-referenced opposition proceeding be suspended pending the resolution of a cancellation action (Cancellation No. 92056654) that is pending before the Board and which involves the same parties and marks.

BACKGROUND

Opposer, Technopharma Limited, seeks to oppose Applicant's registration of the marks FAIR & LOVELY and FAIR & LOVELY (Stylized) for the services covered in Serial Nos. 85818821 and 85818836. In its Notice of Opposition (D.I. 1), Opposer claims that use of Applicant's FAIR & LOVELY mark(s) for the covered services is likely to confuse consumers into believing that there is some association or connection with Opposer or its alleged use of its NEW YORK FAIR AND LOVELY mark, which is

the subject of U.S. Reg. No. 3071686 (“the Asserted Registration”). *See* D.I. 1, ¶¶ 1-2, 13-18. Opposer also asserts that through its ownership of the Asserted Registration, it allegedly has priority of rights as against Applicant. *See id.*, ¶¶ 1, 7.

What Opposer fails to mention in its Notice of Opposition, however, is that on the day Applicant filed its FAIR & LOVELY applications, Applicant petitioned to cancel the now-Asserted Registration on multiple grounds, including on the basis that Opposer had abandoned the mark. *See generally* Cancellation No. 92056654 (“the Cancellation Action”). That action has been litigated by the parties to this new proceeding for more than a year and a half, and trial is set to open in that case later this year. *See id.* (D.I. 21).

ARGUMENT

It is appropriate for the Board to suspend a proceeding if the final determination of another Board proceeding in which the same parties are involved “may have a bearing on the Board’s case.” TBMP, § 510.02(a); *see also* 37 CFR § 2.117(a). In the present case, there can be little doubt that suspension is amply warranted.

As discussed above, Opposer bases its opposition in part on certain presumptive rights it claims to possess by owning the Asserted Registration. *See, e.g.*, D.I. 1, ¶ 7. That registration, however, is the subject of the Cancellation Action, which has been litigated by the parties to the current action since the beginning of last year. The final determination of the Cancellation Action will therefore have a direct—and likely significant—bearing on the outcome of the instant opposition proceeding, thereby warranting suspension until the Cancellation Action has been finally resolved.

CONCLUSION

In view of the above, Unilever Plc respectfully submits that the present opposition proceeding (Opp. No. 91216999) should be suspended pending the resolution by the Board of Cancellation No. 92056654 and, if applicable, by any district or appellate court that may later hear either a direct or *de novo* appeal from the case.

Respectfully submitted,

Date: August 4, 2014

By: /William M. Merone/
Jonathan D. Reichman
Natasha Sardesai-Grant
KENYON & KENYON LLP
One Broadway
New York, N.Y. 10004
Tel.: (212) 425 – 7200
Fax: (212) 425 – 5288

William M. Merone
KENYON & KENYON LLP
1500 K Street, N.W.; Suite 700
Washington, D.C. 20005
Tel.: (202) 220 – 4200
Fax: (202) 220 – 4201

*Counsel for Applicant,
Unilever Plc*

CERTIFICATE OF SERVICE

I hereby certify that the required number of copies of the foregoing *Motion to Suspend Proceedings Due to Pendency of Related Board Action* was served on the parties or counsel as indicated below:

By First Class Mail (Postage Prepaid)

David M. Rogero
DAVID M. ROGERO, P.A.
2625 Ponce de Leon Boulevard; Suite 280
Coral Gables, FL 33134

Counsel for Opposer

Date: August 4, 2014

By: /William M. Merone/
William M. Merone
KENYON & KENYON LLP
1500 K Street, N.W.; Suite 700
Washington, D.C. 20005
Tel.: (202) 220 – 4200
Fax: (202) 220 – 4201

*Counsel for Applicant,
Unilever Plc*